In re application of: Robert Keane, et al
Application No.: 10/608,981   Examiner: Daniel Lastra
Filed: June 27, 2003   Art Unit: 3622

Confirmation No.   6395
Docket No.:   MPJ-D2
Customer No.:   37420

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

This Reply Brief is provided in response to the Examiner's Answer mailed April 29, 2008.

I.   Status of Claims

Claims 1-8 are pending in the application and each of Claims 1-8 stand rejected. No other claims are pending.

II.   Grounds of Rejection to be Reviewed on Appeal

A. Whether Claims 1-3, 5, 7 and 8 are unpatentable under 35 U.S.C. 102(e) as being anticipated by Ryan, Jr. et al. (US 6,173,274) (hereinafter "Ryan").

B. Whether Claims 4 and 6 are unpatentable under 35 U.S.C. 103(a) over Ryan, Jr. et al. (US 6,173,274) (hereinafter "Ryan").

III. Argument

A. Claims 1-3, 5, 7 and 8 are NOT unpatentable under 35 U.S.C. 102(e) as being anticipated by Ryan Jr. et al. (US 6,173,274).

The Examiner argues on pages 6 and 7 of the Examiner's Answer that the Appellant is arguing about a limitation not stated in the claims when the Appellant allegedly argues that because Ryan does not teach a user interface, Ryan does not teach creating an electronic product design. However, the statement by the Appellant referred to by the Examiner is first, taken out of context, and then, misinterpreted. The statement by the Appellant reads: "Since Ryan discloses no **other** software tool having a user interface, Ryan clearly does not teach this limitation." With regard to context, the Appellant's argument leading up to this statement explains why the <u>**only**</u> **software tool** described in Ryan's system, **which is the data processing system 80**, cannot be equated with Applicant's recited "one or more product design software tools, the tools being adapted to (a) allow a **user** to create an **electronic product design**". The Appellant's statement that "Ryan discloses no **other** software tool" refers to the fact that Ryan teaches only the data processing system 80, and no other software tool. The phrase "having a **user** interface" merely points out that the claim requires that the software tools must be "adapted to (a) allow a **user** to create an electronic product design."

Importantly, as explained in the Appellant's detailed argument (page 12, lines 12-21 and page 13, lines 1-13) Ryan has **only one** software tool, namely the **data processing system 80**. As further explained, the only software tool, namely the data processing system 80, processes recipient addresses to **generate corresponding control codes 82** (based on information from a user data profile 804 and third party advertiser profiles 807). The printer system 90 prints the document 17 including its respective control code 82 having the message indicator contained therein. (Ryan, col. 12, lines 43-45). Next, the inserter system 300

including the postage meter module 380 and its associated printer, scans the control code 82 and uses the message indicator to print the selected message 70 on the envelope 20. Generally, the message 70 is printed by the postage meter module 380. The message indicator identifies a selected graphic file previously stored in memory 386 for use in printing the selected message 70. (Ryan, col. 12, lines 45-51).

Importantly, Ryan does not teach or suggest any element that can be equated with Applicant's recited "an electronic product design." The control codes generated by the data processing system 80 are not an "electronic product design" because they are merely codes that instruct the postage meter module 380 of the inserter system 300 which message(s) to print on the envelope 20. The printed envelope 20 is not "an electronic product design" because it is the product itself, and it is not electronic. The messages stored on the postage meter module 380 in memory 386 are not "an electronic product design" because they are merely individual messages that may be printed on envelopes by the printer 372 of the postage meter module 380. Thus, the messages are merely potential individual components of a number of elements to printed on an envelope by the postage meter module 380. Furthermore, since the data processing system 80 does not allow a user to create the messages stored in the memory 386 of the postage meter module for use in printing the message on an environment, and therefore clearly does not generate "an electronic product design", and since there is no other software tool in Ryan that allows creation by the user of a design to be stored in the postage meter memory 386 and printed on an envelope, then it should be clear that Ryan simply does not teach or suggest "one or more product design software tools, the tools being adapted to (a) allow a **user** to create an **electronic product design**."

The Examiner argues on page 8 of the Answer that the Appellant argues about limitations not in the claims when the Appellant argues that in Ryan's system it is the **user** that **provides** a message for incorporation into the electronic product design either **through active selection** from available messages presented to the

user by the system 80, or by indicating to the system 80, via the user data profile 804, to select the message with the highest paying subsidy. In either case, as explained in the Appeal Brief, in Ryan's system, it is the **user,** and not the data processing system 80 software tool itself or the third party advertisers, that **selects** the message to be printed, and therefore it is the **user** that **provides** a message for incorporation into the items to the be printed on the envelope through the act of selection of the messages.

Even if it is determined that the act of selection of the messages is not the equivalent of providing the messages, Ryan still does not meet this limitation because regardless of whether it is the user or a third party who actually provides the advertisements in Ryan, the advertisements in Ryan are still not incorporated into an electronic product design because, as explained above and in the Appeal Brief, there is no element or combination of elements in Ryan that teach "an electronic product design" into which the selected message(s) are incorporated. The selected message(s) are merely printed during the printing of the postage by the postage meter when the postage meter module 380 scans the control code 82 on the envelope, reads the message indicator embedded therein, and then turns on printing of the selected messages as indicated by the message indicator. There is simply no form of the entire electronic product design anywhere in the system.

The Examiner argues on page 8 and 9 of the Answer that the Appellant argues about limitations not in the claims when the Appellant argues that in Ryan's system the user must actively select a message to incorporate into the printed envelope, whereas in Applicant's claimed method, the user action is the active selection **not** of which message to select, but rather of **whether to opt in or out of a non-user-provided incorporated advertisement**. The Appellant replies that none of the messages that may be printed by the postage meter module 380 in Ryan's system are incorporated into any envelope design without being selected by the user to be printed on the envelope. Thus, Ryan's system does not first "incorporate into the design an advertisement not provided by the user", and then,

after incorporating the selected message(s) into the design, "offering the user the option of removing the advertisement." In Ryan's system, the user is offered the option of **adding** advertisements in order to recoup a subsidy. Never is the user required to have an advertisement first and then offered the opportunity to remove the advertisement.

On pages 10 and 11 of the Answer, the Examiner argues that "Ryan teaches a data processing system 80 under the control of a user that produces high volume customized mailpieces (i.e. electronic product design) where set processing system allows said user to automatically incorporate advertisements into all mailpieces in a product design but with the option of allowing said user to restrict the advertisements to be printed in specific mailpieces by allowing said user to remove advertisements from specific mailpieces." Appellant replies that the Examiner appears to be equating customized mailpieces with "an electronic product design". However, as explained previously, there is no "electronic product design" for any of the mailpieces. The inserter system scans the control code 82 printed on the envelope, interprets the message indicator embedded therein, and then prints the message(s) indicated by the message indicator. The design of each particular mailpiece is not embodied or stored anywhere in the system. The printed design on the envelope is the result of the postage meter printing the selected message(s) in response to a control code previously printed on the envelope. The components of the envelope design are therefore determined (from the control code 82) and printed in realtime so that there is no embodiment that constitutes "an electronic product design" of the resulting printed envelope design.

On pages 11 and 12 of the Answer, the Examiner argues that Ryan's Fig. 3 can be construed as a "template" as it shows a product which has fixed and variable content for the purpose of expedited printing. Appellant replies that Fig. 3 of Ryan is a front view of an envelope **that has been processed by the production mail system** in accordance with Ryan's invention. (Ryan, col. 4, lines 57-59). Ryan discusses in col. 7, lines 1-25 the various components printed on an envelope that

has been processed by Ryan's system, including postal indicia 30, sender address 40, recipient address 50, and ads 60a-60d. However, the envelope 20 is not a template of an electronic product design - rather it is the final printed product. Nothing in Ryan teaches or suggests that the front view of the envelope 20 is a template which allows "the user ton incorporate user content into the template to create an electronic product design", as required by Applicant's claim 2.

On page 13 of the Answer, the Examiner argues that Ryan teaches allowing users to automatically include advertisements in all mailpieces, where said users would be credited for said including except for the mailpieces that the Ryan's users indicate to not include advertisements. The Examiner further argues that the user would have to pay a full price fee for mailing mailpieces that do not include said advertisements as said user would not be credited for including an advertisement in said mailpieces. Appellant replies that the claim recites "wherein the user must pay a fee to have the advertisement removed" and Ryan does not teach removing any advertisement. Ryan only teaches selecting an advertisement to be printed on the envelope but does not teach removing an advertisement once it has been selected and incorporated into the control code 82 that is read by the inserter system.

On page 14 of the Answer, the Examiner argues that in Ryan, the mailpieces are not entirely designed by the printer because Ryan teaches that the user controls what messages and content would be printed in each mailpieces. Appellant replies that there is still no "electronic product design" of any individual envelope to be printed. As explained previously, a control code 82 previously printed on the environment is scanned by the inserter system and interpreted to enable printing of one or more pre-stored messages on the envelope. The control code 82 is not a design, but merely instructions.

On page 15 of the Answer, the Examiner argues that Appellant is not even challenging the Official Notice taken in the obviousness rejection in rejecting
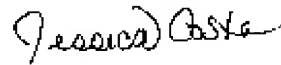
claim 4 because the Applicant argues that Ryan does not teach or suggest the limitation "wherein the tools are provided by a business to the user at no charge and wherein the advertisement is a promotional message for the business providing the tools." In the Final Rejection, the Examiner takes Official Notice that "it is old and well known in the promotion art that manufactures pay to insert their ads in flyers or printed papers. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the Ryan's postage meter manufacturers (i.e., business) would be motivated to pay users for inserting said manufacturers' ads into said users' envelopes in order to give said users an incentive to participate in said manufacturers' system." However, the Official Notice does not address the claimed limitation that "the tools are provided by the business to the user at no charge". The Official Notice only alleges that manufacturers pay to insert their ads in flyers or printed papers. It is not old and well known in the promotion art, however, to provide a product design software tool at no charge.

Conclusion

For the reasons set forth above, Applicant respectfully submits that each of Claims 1-8 is patentable and reversal of all rejections is respectfully requested.

Respectfully submitted,

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Jessica Costa, Reg. No. 41065
VistaPrint USA Inc.
95 Hayden Avenue
Lexington, MA 02421
Phone: 781-652-6563
Fax: 781-652-7208